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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**In re Application of:** Peppel et al.  
**Serial Number:** 09/735,586  
**Filed:** 12/12/00

**Docket No.:** OOMP0001C  
**Group Art Unit:** 2132  
**Examiner:** B. Lanier

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**Title:** Electronic Trading Card

15 5 May 2003

Commissioner of Patents and Trademarks  
Washington, DC 20231

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**RESPONSE**

25 Sir:

This Response is provided to the Office Action dated 3 February 2003.

30 1. Initially, Applicant extends thanks and appreciation to the Examiner, Mr. Lanier, and to Supervisory Patent Examiner, Mr. Barron, for their assistance and counsel during interview held 31 March 2003.

In connection with the interview, Applicant notes that the Examiner indicated a  
35 proper response would show the connection from the claim language, to the Specification, to the 1.131 declaration.

The Interview Summary indicates that the Examiner was of the opinion that the 1.131 declaration may not support the specific embodiments of Claim 4, "which the Smith reference discloses" to overcome the rejection by preventing a *prima facie* case of the effective date that the Applicant is asserting.

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Applicant observes that during the interview there was some disagreement as to whether an effective 1.131 declaration overcoming a cited reference in connection with an independent base claim would be sufficient in connection with claims that were dependant thereon. It was and remains Applicant's position that any  
10 declaration under 1.131 that is effective to swear behind a cited reference in connection with the base claims of an application disposes of that reference for all claims. That is, if the subject matter of a base claim is novel and an unobvious, for example because a cited reference has been removed pursuant to a 1.131 declaration, then a narrower claim, that is a dependent claim, cannot lack novelty or  
15 be obvious by definition. Simply, the subject matter of the parent claim being patentable, any narrowing limitations added to that subject matter would as well be patentable.

In terms of overcoming a rejection by use of a 1.131 declaration to swear behind a  
20 cited reference, it is not necessary that the Applicant show conception and diligent reduction to practice for the dependent claims. Rather, the Applicant only need show that the subject matter of the base claims was conceived and that diligent reduction to practice was applied to swear behind the reference. In support of this position, the Examiner is directed to 37 CFR § 1.131(a) which is concerned with "when any claim  
25 of an application... is rejected..." (see also MPEP 715). Should the Examiner deem Applicant's submission pursuant to 37 CFR § 1.131 sufficient overcome the rejection with regard to a base claim, then that claim is allowable and by definition any claim depending therefrom would also be allowable.

30 2. In connection with the foregoing discussion, Applicant notes that Claims 1-7, 9, 10, 13-17, 19, 20, 22, 22-35, and 37 stand rejected under 35 U.S.C. §102 (e) as being anticipated by Smith. In Applicant's response of 14 November 2002, the Examiner was directed to the various exhibits contained in Applicant's submission

under 37 CFR §1.131, which was made pursuant to the parent case from which this case is derived (U.S. patent number 6,200,216).

5 The dispositive issue here is identified by the Examiner in the Interview Summary discussed above, and concerns whether there is sufficient evidence in the 37 CFR §1.131 declaration in connection with the term "rare card" in showing Applicant's possession of the concept of "content scarcity as a hidden portion of an electronic card or time limit on the availability of an electronic card," as set forth in the Office Action (page 2, the Examiner indicated that "evidence is needed to support  
10 Applicant's disclosure").

During the course of the interview Applicant directed the Examiner to such evidence, in particular tab E from paper 5, as noted by the Examiner in the Interview Summary. On page 6 of the document at tab E (Response Based on Decision on Appeal),  
15 Applicant points out support for the notions of card scarcity and card authenticity. This section of tab E was discussed with the Examiner.

One concern mentioned by the Examiner during the interview is that the documents relied upon by Applicant in the 1.131 declaration referred to a "rare" movie card.  
20 Applicant notes that a synonym for the word "rare" is the word "scarce." (source: Webster's revised unabridged dictionary, copyright 1996, 1998 Micra, Inc.). Thus, the notion of Tim's friend Gerry giving him a "rare" movie card at school for which Tim's friends "have been searching... for weeks" supports the notion of scarcity. Applicant is of the opinion that the connection from the claim language "scarcity" to  
25 the declaration "rare" is sufficient to provide support for Applicant's swearing behind the cited reference.

Applicant appreciates that the Examiner also was concerned that the Specification may not provide a proper link from the 1.131 declaration to the claim language.  
30 Applicant notes that the application as filed must be taken as a whole and that the claims submitted with the application are considered part of the disclosure. As such, the parent application was submitted in its original form with the notions of scarcity and authenticity.

Applicant also points the Examiner to the Specification to show additional support. Thus, the Examiner should refer to the following:

5       The trading card format is embodied in all components of the electronic trading card system. These components are designed to generate and accept a shared proprietary electronic trading card format, so that, for example, a card created and a card – making application can be recognized by an electronic creating card album. The card format is also important because it supports the concepts of scarcity and authenticity (essential to card collecting and trading) within a disassociated computer code segment. (page 5, lines 10       11-18; emphasis added)

And:

15       The card format is also important because it supports the concepts of scarcity and authenticity (essential to card collecting and trading) within a disassociated computer code segment. (page 8, lines 1-4).

For purposes of further defining card scarcity in connection with the Specification, it should be appreciated that card scarcity is a function of information contained within an electronic trading card shown in Figure 1. For example, utility programs include such items as password protection. However, scarcity is also provided in other ways. For example a card may include a game or puzzle (see 39 on figure 1). If the user solves the puzzle, the program within the card makes the card rarer. Scarcity is also implemented by timing factors, copy protection, limited manufacturing, and random distribution. These items are all set forth in the patent application in the discussion following that of Figure 5 and before that of Figure 6.

30       The card format is important also because the card may only be valuable is the card is authentic. To the extent that pirated versions of the cards may be available in the market, there is doubt as to the authenticity of the card, and the value and scarcity of the card suffers. The application discusses the provision of the public key/private key encryption technique to allow recipients of the card to confirm the authenticity and source of the card. Authenticity is implemented using an electronic trading card

engine in conjunction with the electronic trading card. Again, this is discussed in detail in the application.

One area in which authenticity is implemented in the electronic trading card of Figure 1 is in the area where utility programs are stored, e.g. password protection. Authenticity and password protection may be separate or combined functions in the electronic trading card. Typically, the electronic trading card is authenticated in one of the public keys recognized by the card. Thus, password schemes implement a technique for verifying the authenticity of the card.

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Applicant also directs the Examiner's attention to page 10 of the application, at line 5 where a section entitled "ETC Scarcity," is provided. In this section of the application, the words "scarcity" and "rare" and "rarest" are used interchangeably. The concept of scarcity is found at several other places in the application and Applicant's discussion herein is by no means exhausted but merely illustrative.

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Applicant particularly draws the Examiner's attention to the examples on page 22 in the application. The Examiner will note that the discussion of a "rare movie card" is identical to that set forth in document BC2 of Applicant's 1.131 declaration. Document BC2 appears at tab E in Applicant's previous submission, toward the back of that exhibit.

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With regard to the sufficiency of Applicant's 1.131 declaration in overcoming the cited reference, Applicant refers the Examiner to the MPEP § 714.02 in which it is stated "where the differences between the claimed invention and the disclosure of the reference(s) are so small as to render the claims obvious over the reference(s) an affidavit or declaration under 37 CFR § 1.131 is required to show no more than the reference shows." Here, Applicant's declaration shows considerably more than that of the cited reference and is commensurate in scope with both the disclosure in the Specification and with the scope of claim coverage sought herein. Accordingly, Applicant respectfully requests the Examiner reconsider the Examiner's refusal to accept Applicant's declaration under 1.131 and to withdraw the Smith reference as prior art.

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3. Claims 9, 13, 33, 34, and 37 stand rejected under 35 USC § 102(b) as being anticipated by Durst, U.S. patent number 5,022,080.

Applicant respectfully disagrees.

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Durst merely shows an electronic notary, *i.e.* an authentication scheme. Durst's scheme takes a document to be authenticated and produces a digest of the document. The digest is hashed with a time code to produce an authenticated document. Nowhere in Durst is there the notion of scarcity. While the Examiner  
10 refers to Durst as showing scarcity, a careful examination of the Durst document reveals that Durst's only concern is with the notion of notarizing electronic documents, *i.e.* the authentication of documents. While an authentication scheme of the kind taught Durst could be used in connection with the practice of the invention claimed herein, the invention claimed herein further includes the notion of a  
15 mechanism for producing scarcity, as discussed above and as discussed in great detail in the Specification of the subject application. Accordingly, Durst fails to teach and every element of the claimed invention and is therefore improper as an anticipating reference. Therefore, it should not be cited against the subject application in connection with the issue of novelty. Accordingly, Applicant  
20 respectfully requests that the Examiner withdraw the rejections herein in connection with Durst.

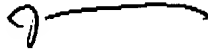
4. The various claim rejections under 35 USC § 103 are deemed moot in view of the allowability of the base claims from which the claims rejected for obviousness  
25 depend. To the extent that the base claims are allowable, the claims which depend therefrom are also allowable *per se*.

5. Applicant notes that the Examiner has made a non-statutory double patenting rejection based on the judicially created doctrine of double patenting. Upon receiving  
30 indication of allowable subject matter herein, Applicant will timely file a Terminal Disclaimer in compliance with 37 CFR § 1.321 to overcome this rejection in which Claims 1 and 9 herein would be disclaimed to Claims 2 and 1, respectively, of U.S. patent number 6,200,216.

6. Applicant thanks the Examiner for careful consideration of the discussion presented herein and for an early determination of patentability. Should the Examiner deem it helpful to discuss any of the issues addressed herein with Applicant, he may contact Applicant's attorney, Michael A. Glenn at (650) 474-8400.

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Respectfully submitted,



Michael A. Glenn

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